

REMARKS

Claims 1, 7-14, 16, 17, 19 and 21 have been cancelled. Claim 3 has been amended in independent form, including all limitations of base claim 1. The amendment of claim 3 in independent form makes no change to the scope of claim 3. Claim 15 has been amended in independent form, including all limitations of base claim 14. The amendment of claim 15 in independent form makes no change to the scope of claim 15. Claims 2 and 4-6 have been amended to change their dependence from claim 1 to claim 3. Claims 18 and 20 have been amended to include limitations corresponding to those present in claims 3 and 15. Claims 2-6, 15, 18 and 20 are pending in the case. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicants note with appreciation the withdrawal of the rejection of the claims under 35 U.S.C. 102(b) as being anticipated by USP 5,448,760 to Fredrick.

Claims 1-6, 14-15, 18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2003/0137685 A1 to Meade, II. The rejection of claims 1 and 14 is made moot by the cancellation of these claims. The rejection of claims 2-6, 15, 18 and 20 is respectfully traversed.

With respect to the rejection of claim 3, the Examiner states:

In regards to claims 3 and 4, Meade 11 discloses breaking down usage into pixel/toner and paper into separate categories of costs so that a user can better automatically measure costs on a 100% pay-for-what-you-use basis (Meade 11: page 5, paragraph 0051). Since the user is charged by how much they use, it is inherent that there is a reference value of price per page, for example. This meets the limitation of "amount acquisition means for acquiring a usage amount record of the office automation device based upon device usage information stored in the information storage means, comparison means for comparing the usage amount record and a reference value and producing a comparison result; and output means for outputting a message corresponding to the comparison result" . . .

The rejection of claim 3 is respectfully traversed.

Claim 3 defines a system for managing a networked office automation device comprising a number of elements in combination. The claimed combination includes verification means, information acquisition means and information storage means. In the claimed system a usage

amount record of the device is acquired based on device usage information stored in the information storage means. This is compared with a reference value. A message corresponding to the comparison result is output.

In clear contrast, Meade (at cited paragraph 0051) discloses the precise tracking of cost by eliminating cost averaging. Meade discloses taking costs directly from management information base entries of completed hard-copy events. Meade discloses breaking pixel/toner usage and paper into separate cost categories to better automatically measure costs on a 100% pay-for-what-you-use basis.

The Examiner asserts that since the user in Meade is charged by how much they use, Meade “inherently” discloses a reference value of price per page (for example). According to the Examiner, this inherent disclosure meets the limitation of three elements: (a) amount acquisition means, (b) comparison means, and (c) output means.

This rejection, based on grounds of inherency, is respectfully traversed. For Meade to render claim 3 unpatentable on grounds of inherency, the inherency must be certain. *Ex parte Cyba* (POBA 1966) 155 USPQ 756; *Ex parte McQueen* (POBA 1958) 123 USPQ 37. The fact that Meade might have the characteristics of the claimed invention is not sufficient. *Ex parte Skinner* (BPAI 1986) 2 PQ2d 1788. Inherency must be a necessary result, not merely a possible result. *In re Oelrich* (CCPA 1981) 666 F2d 578, 212 USPQ 323; *Ex parte Keith et al.* (POBA 1966) 154 USPQ 320; *In re Seaborg* (CCPA 1964) 328 F2d 993, 996, 140 USPQ 659, 662.

With respect to Meade, the “inherency” of the system defined by claim 3 is not at all certain. A system which meets the claim 3 requirement of “a usage amount record . . . acquired based upon device usage information stored in the information storage means and compared with a reference value, and a message corresponding to a comparison result is output” is by no means a necessary or even likely result of the technique disclosed in Meade.

Meade discloses a 100% pay-for-what-you-use cost tracking system. Meade fails to disclose or suggest a system which compares an acquired usage amount record based on stored device usage information with a reference value, and then outputs a message corresponding to the comparison result. Such comparison is neither required nor inherent in Meade. For example, Meade’s pay-for-what-you-use cost tracking system may be implemented by simply (a) counting the number of pages

used, (b) multiplying the number of pages by the price per page, and (c) charging the customer for the pages used. Comparing an acquired usage amount record based on stored device usage information with a reference value is not disclosed in Meade and is not necessary in Meade. Outputting a message corresponding to the comparison result is not disclosed in Meade and is not necessary in Meade. Meade does not inherently disclose or suggest the invention defined by claim 3.

Claims 2 and 4-6 have been amended to depend from claim 3. It is respectfully submitted that claims 2 and 4-6 are patentably distinct from Meade for the reasons stated above with respect to claim 3.

With respect to claim 15, the Examiner stated:

In regards to claim 15, Meade 11 discloses the tracking apparatus collects usage information for consumables utilized to generate a print job. This enables proper allocation of costs to specific print jobs, which better enables a user to track costs for consumable usage and distribute such costs between particular print jobs and/or customers who have request generation of such print jobs via LAN environment (Meade II: page 3, paragraph 0027-0028). This meets the limitations of "processing usage information stored in the database, based on a comparison of the amount of usage and a reference value, sending a message corresponding to the comparison result to at least one of a user of the office automation device and an administrator of the office automation device."

The rejection of claim 15 is respectfully traversed.

Claim 15 defines a method for managing usage of a networked office automation device comprising a number of steps in combination. The claimed combination includes verifying a user and obtaining an amount of usage of the device by the user. Usage information of the device is acquired and stored. The stored usage information is processed. The amount of usage and a reference value are compared. A message corresponding to the comparison result is sent to the user and to the administrator of the device.

In contrast, Meade (at cited paragraphs 0027-0028) discloses a tracking apparatus that collects use information for consumables used to generate a print job. The cost of consumables used for a particular print job can be determined, enabling proper allocation of costs to specific print jobs. For example, in a law firm, a user can track the actual usage information for specific print jobs so that the costs can be properly allocated and billed to each client.

There is no teaching or suggestion in Meade of method, like that defined by claim 15, of processing the usage information stored in the database and, based on a comparison of the amount of usage and a reference value, sending a message corresponding to a comparison result to at least one of a user of the office automation device and an administrator of the office automation device.


Claims 18 and 20 have been amended to include limitations corresponding to those present in claims 3 and 15. It is respectfully submitted that claims 18 and 20 are patentably distinct from Meade for the reasons stated above with respect to claims 3 and 15.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 116692000300.

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